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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,808	03/03/2000	Yoji Kawamoto	7217/31035	5769

7590

05/13/2005

Jay H Maioli
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

NEURAUTER, GEORGE C

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/518,808

Applicant(s)

KAWAMOTO ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1 and 3 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 April 2005 has been entered.

Response to Arguments

Applicant's arguments filed 14 April 2005 have been fully considered but they are not persuasive.

The Applicant argues that Kawano does not teach or suggest converting message information from a first data format incompatible with the type of terminal device being used by the user to a second data format compatible with the terminal based on terminal and media type attributes associated with the terminal. The Examiner does not agree. Kawano discloses:

"It is a further object of the present invention to provide a method and an apparatus for evaluating a favor and a using history of each end user, selecting a service of an information

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providing computer for meeting the evaluated result, and supplying the selected service. The method and apparatus preferably make it possible to change a service to be provided by the end user if a new addition or a change of a service of the information providing computer takes place, change the providing service [by] evaluating an environment and quality of service/information of the system, and deputize some works such as application for admission to use of the service for an information providing computer when the services of plural information providing computers are received in an integrated manner, arrangement among the services, and payment of a service cost to an information provider." (column 2, lines 8-24)

"The service providing system 1061C uses the service type for the condition information specified by the retrieval process of the service mediate managing unit 102. The user of the server specifies the attribute information of the service to be provided under this condition. The attribute information describes the conditions of the service to be provided by the user of the server, including a fare, a providing time, a deposit place, a bank account, a list of bank accounts where his or her salary is to be paid, and so forth. Based on these conditions, the most approximate service type and server are retrieved in response to the request issued from a service

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requesting client. This makes it easier to change the service
for meeting the request for the end user according to the
environment of the system and the quality of the
information/service. By integrating the service interfaces of
various types with each other and notifying the client of the
information item at a normal time, it is possible to select the
most approximate service condition to that time point. This
results in making it easier for the end user to integrally
evaluate the status and select the approximate service to the
change. (column 9, lines 25-47)

Based on the teachings of Kawano, Kawano discloses that
messages are converted from a first format incompatible with the
type of terminal device being used by the user to a second data
format compatible with the terminal based on terminal and media
type attributes associated with the terminal or "chang[ing] the
service for meeting the request for the end user according to
the environment of the system" and "integrating the service
interfaces of various types with each other and notifying the
client of the information item".

In terms of the claim's broadest reasonable interpretation,
the limitation "converting message information a first format
incompatible with the type of terminal device used by the user
to a second format compatible with the terminal based on

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terminal and media type attributes" has a plurality of interpretations, including wherein the first format is in a format that does not correspond with the environment of the system of the end user and the first format is changed to a second format according to that environment including terminal and media type attributes or "environment" and "service interfaces of various types" as taught in Kawano.

Therefore, Kawano does disclose the limitations of the claim and the case is not in condition for allowance based on the amendments made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 697 836 B1 to Kawano et al.

Regarding claim 1, Kawano discloses a network system connecting a plurality of different types of user terminal

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devices (referred to throughout the reference as "clients") and a network server ("service mediate server") via a known communication system, wherein each of said plurality of different types of user terminal devices comprises:

means for retrieving information from a removable memory ("IC card"; column 10, lines 33-38; column 10, lines 33-38) storing user specific information ("service requester information") (column 10, lines 23-42), and

means for transmitting said user specific information and information identifying a type of terminal device said plurality of different types of user terminal devices used by a user ("client terminal information") as specific information ("service request message") when said removable memory is loaded, wherein said information identifying said type of terminal device includes terminal type attributes and media type attributes corresponding to said type of terminal device ("condition information" and "service interface"; column 5, lines 38-45; column 9, lines 35-47; see also Figure 3, element 1051c); (column 10, lines 23-42; column 11, lines 27-38) and

said network server comprises:

means for receiving said specific information transmitted by said type of terminal device used by said user, (column 11, lines 27-38)

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means for registering said user specific information and said information identifying said type of terminal device included in said specific information, (column 7, lines 21-31; column 8, lines 24-45; column 11, lines 33-38)

means for identifying said type of terminal device being used by said user and for authenticating said user by referring to said registered information, (column 11, lines 39-53)

means for converting ("changing") message information addressed to said authenticated user to a data format compatible with said type of terminal device based on said terminal type attributes and said media type attributes of said terminal device being used by said user (column 2, lines 8-24; column 9, lines 25-47; column 11, line 54-column 12, line 14), and

means for transmitting said converted message information to said type of terminal device being used by said user.

(Abstract, specifically "The information received by [a server] is processed by the service mediate agent and the processed information is transmitted to [a client]."; column 9, lines 25-47, specifically lines 65-66)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al.

Regarding claim 3, Kawano discloses the network system according to claim 1.

Kawano does not expressly disclose wherein said means for registering erases said registered information when said memory means is extracted from said terminal device, however, Kawano does disclose the use of an memory means as a portable medium as shown above. Kawano also discloses wherein the memory means contains user specific information that uniquely identifies a user and contains information exclusive to the user (column 7, lines 21-31; column 8, lines 33-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to erase the registered information when the memory means is extracted from the terminal device as disclosed in Kawano. Kawano discloses the memory means as a portable medium, which means that the user uses the memory means as a means to use his or her exclusive information to obtains service from a server for a temporary period of time. One of ordinary skill would recognize this fact and would have considered it obvious that the memory means would eventually be removed when the user no longer required the services of the server. It would logically follow that the registered user's

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information would no longer be valid at the terminal at which the user used the memory means to obtain service from the server and the user's information would be considered invalid and, at some point in time, erased by an express deletion or by being overwritten by new values.

Therefore, it would have been obvious to achieve the limitations as claimed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches the state of the art in converting data from one format to another based on terminal and media type attributes:

US Patent 5 966 448 to Namba et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

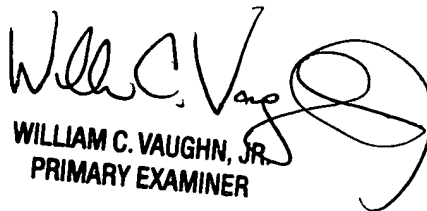
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER